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EXAMINER

HARBECK, TIMOTHY M

ART UNIT	PAPER NUMBER
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3692

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/17/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/006,733	Applicant(s) MARVIN ET AL.	
	Examiner Timothy M. Harbeck	Art Unit 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/30/2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-9 and 11-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The present invention appears to be directed toward a number of subjective determinations of grades, validity and success of a business opportunity analysis. The invention cannot be used as intended without undue experimentation, as each users subjective analysis would alter the result.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-9 and 11-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A useful, concrete and tangible result must be either specifically recited in the claim or flow inherently therefrom. To flow inherently therefrom, it must occur. If there is a reasonable exception or it is merely likely that it would occur, it does not "flow inherently therefrom" and the claim would

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need to be amended to specifically recite the result. The second factor in this test for practical application is a determination of whether the claimed invention produces a concrete result. Usually, this question arises when a result cannot be assured. In other words, the process must have a result that can be substantially repeated. Note that the focus is on the result, not the steps themselves. For example, concrete data processing steps could still produce an unrepeatable result if the data being processed is subjective. However, the mere fact that the result is an estimate, prediction or other approximation that may not ultimately be found to be accurate is not a determinative factor for concreteness. Thus, an assured result refers to repeatability and ability to achieve a result rather than ultimate accuracy of the result. The present invention appears to be directed toward a number of subjective determinations of grades, validity and success of a business opportunity analysis. The result of these steps depends on the subjective opinion of certain persons of the process (i.e. opportunity analysis, determination of success ect), and the result of these steps might be different depending upon the individual or individuals. The invention cannot be used as intended without undue experimentation, as each users subjective analysis would alter the result.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-9 and 11-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maxwell (US 6,195,643 B1) in view of Karszes (Jason Karszes & Wayne

Knoblauch "Five Points help evaluate new technology." Found at:

<http://www.dairybusiness.com/northeast/Feb01/5points.htm> on 7/18/06)

Re Claim 1: Maxwell discloses an evaluation and decision making process comprising the steps of:

- Collecting data for ideas from a plurality of sources (Column 4, lines 58-63; packages A, B and C)
- Performing an opportunity analysis on said identified potential business opportunities to determine valid business opportunities (Column 5, lines 42-65)
- Committing resources to said valid business opportunity (Column 2 lines 17-19 and Column 6, lines 55-57)

Maxwell does not explicitly disclose the steps of:

- Identifying core equities of the organization
- Filtering said collected idea data by identifying potential business opportunities as those collected ideas that fall within the identified core equities
- Developing a business proposal for said valid business opportunities;
- Submitting said developed business proposal to a potential buyer of said valid business opportunity;

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- Determining if submission of said developed business proposal is a success and;
- Executing said business opportunity upon determining that the submission is a success

Karszes discloses evaluating business proposals by identifying core equities of the organization (Page 1, Step 2; 'determining whether a technology fits your business') and filtering said collected idea data by identifying potential business opportunities as those collected ideas that fall within the identified core equities (Pages 1-2, Steps 2-3; specifically step 3 'does your dairy have all the necessary practices, supplies, feeds, personnel and other resources in place and working properly to take advantage of the new practice or product?'). It would have been obvious to a person of ordinary skill at the time of invention to include the steps of Karszes to the disclosure of Maxwell in order to systematically determine if a company should incorporate a new product, process or technology to the existing structure of the business.

Official Notice is taken that the steps of developing and submitting a proposal, determining the success of the proposal and the subsequent execution of the proposal were notoriously old and well known in the art at the time of invention. This is how any business, seeking either to market a new opportunity, or seeking a particular service from an outside source, operates. It would have been obvious to a person of ordinary skill in the art at the time of invention to include this step to the disclosure of Maxwell to allow for a symbiotic match of potential partners in a venture and ensures that all the steps necessary to achieve the goal of the venture are met.

Re Claim 2: Maxwell in view of Karszes discloses the claimed process supra and Maxwell further discloses wherein said filtering step is filtering formal announcements and further includes the steps of:

- Reviewing said formal announcements for potential business opportunities by a first designated point of contact (Column 4, lines 58-59 "decision maker is presented with the choice of packages)
- Retaining said formal announcements in said business development database for future reference (Column 4, lines 35-39; "product database")
- Identifying formal announcements that are within a predetermined scope of business by a second designated point of contact (Column 5, lines 42-55)

Maxwell does not explicitly disclose the steps of:

- Distributing a list of the identified announcements to a business development team;
- Conducting a review of all said identified announcements by the business development team; and
- Selecting specific opportunities from announcements reviewed at said step of conducting a review;
- Forwarding said specific opportunities from said step of selecting as identified potential business opportunities; and
- Archiving all non-selected opportunities remaining after said step of selecting

Official Notice is taken that the steps of distributing and reviewing a list of opportunities by a management team, selecting specific opportunities, moving forward with the selected opportunities while archiving non-selected ones were notoriously old and well known in the art at the time of invention. Any business seeking to select from a variety of choices or opportunities, does not do so randomly, but by some form of analysis of each opportunity relative to the goals of said business. Furthermore a human review panel for such opportunities was used and is still used to make these determinations. It would have been obvious to a person of ordinary skill in the art at the time of invention to include this step to the disclosure of Maxwell so that a business can take advantage of the collective intellect of their human personnel to ensure that an optimal choice is made.

Re Claim 3: Maxwell in view of Karszes discloses the claimed process supra and Maxwell further discloses wherein said step of performing an opportunity analysis includes the steps of:

- Grading strengths and weaknesses of the identified potential business opportunities (Column 5, lines 9-41)
- Entering project identifying information into a computer for creating a master form (Fig 4)
- Automatically summarizing graded areas on the master form (Fig 4 and Fig 5)
- Committing resources to a valid business opportunity (Column 2 lines 17-19 and Column 6, lines 55-57)

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Maxwell does not explicitly disclose the steps of:

- Collecting ideas from a plurality of sources;
- Identifying core equities of the organization
- Filtering said collected idea data by identifying potential business opportunities as those collected ideas that fall within the identified core equities
- Performing an opportunity analysis on said identified potential business opportunities to determine valid business opportunities

Karszes discloses evaluating collected business proposals by identifying core equities of the organization (Page 1, Step 2; 'determining whether a technology fits your business'), filtering said collected idea data by identifying potential business opportunities as those collected ideas that fall within the identified core equities (Pages 1-2, Steps 2-3; specifically step 3 'does your dairy have all the necessary practices, supplies, feeds, personnel and other resources in place and working properly to take advantage of the new practice or product?'), and performing an opportunity analysis on said identified opportunity to determine its validity (Pages 2-3; Steps 4-5 'Financial Feasibility' and 'Risk Evaluation').

Maxwell in view of Karszes does not explicitly disclose the step wherein

- Said grading occurring in areas of market, economics, competitive advantage, the team, and potential flaws, each area including plural criteria and a high low attractive assessments for each

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However Maxwell notes that the "nature of the products in the product database will define the context and content of the questions to which the decision maker responds" (Column 4, lines 37-39). It would have been obvious to a person of ordinary skill to include the grading in areas of market, economics, competitive advantage, the team, and potential flaws when evaluating potential business opportunities, as the nature of these opportunities require questions related to these factors.

Maxwell does not explicitly disclose

- Archiving opportunities having an overall low attractive summarized score;
and
- Forwarding identified potential business opportunities having an overall high attractive summarized score as valid business opportunities
- Developing a business proposal for said valid business opportunities;
- Submitting said developed business proposal to a potential buyer of said valid business opportunity;
- Determining if submission of said developed business proposal is a success and;
- Executing said business opportunity upon determining that the submission is a success

Official Notice is taken that the step of choosing attractive options while passing on less attractive options was notoriously old and well known in the art at the time of invention. It would have been obvious to include this step to the disclosure of Maxwell

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so that the business chooses the opportunity that is best for its goals, based upon the criteria analyzed.

Official Notice is taken that the steps of developing and submitting a proposal, determining the success of the proposal and the subsequent execution of the proposal were notoriously old and well known in the art at the time of invention. This is how any business, seeking either to market a new opportunity, or seeking a particular service from an outside source, operates. It would have been obvious to a person of ordinary skill in the art at the time of invention to include this step to the disclosure of Maxwell to allow for a symbiotic match of potential partners in a venture and ensures that all the steps necessary to achieve the goal of the venture are met.

Re Claim 4: Maxwell in view of Karszes discloses the process according to claim 3 and Maxwell further discloses the steps further comprising the step of representing each area by a separate electronic worksheet wherein the step of grading includes assigning a numeric value to each criteria according to the project parameters, computing a score for that worksheet and transferring the computed score to the master form (See Fig 4; and Column 6 lines 1-30)

Re Claims 5-9: Maxwell in view of Karszes discloses the process according to claim 4 but does not explicitly disclose all the criteria associated with market, economic, competitive advantage, team and potential flaw data. However Maxwell notes that the "nature of the products in the product database will define the context and content of the questions to which the decision maker responds" (i.e. criteria; Column 4, lines 37-39; Also note the variety and depth of question in FIG 4)). In addition, Karszes discloses

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market criteria ('value added' Step 4; 'Is it a profitable decision.'), economic criteria ('return on investment capability' Steps 4-5 'Cash Flow' analysis and "5% ROI"), comparative advantage criteria (Step 5 'If the farm doesn't adopt this technology, how is it positioned in the future? And fixed and variable costs in 'Cash Flow' analysis). It would have been obvious to a person of ordinary skill to include the grading in areas of market, economics, competitive advantage, the team, and potential flaws when evaluating potential business opportunities, as the nature of these opportunities require questions related to these factors. Each business has different criteria, and allowing the business to design its own evaluation criteria and questions that best suits its goals ensures that the most optimal decision is made.

Re Claim 10: Maxwell in view of Karszes discloses the process according to claim 1 but does not explicitly disclose wherein said step of performing an opportunity analysis includes the step of conducting a risk and reward assessment. Karszes discloses steps and methods to analyze the potential of a new business opportunity, including a risk-reward assessment (Page 2, Numeral 5). It would have been obvious to a person of ordinary skill in the art at the time of invention to include the teachings of Karszes to the disclosure of Maxwell so that every decision balances the risk of not adopting something new against the risk of adopting technology.

Re Claim 11: Maxwell in view of Karszes discloses the process of claim 10 and further discloses wherein said risk and reward assessment step includes:

- Identifying a risk factor in relation to said risk benchmark value for each of said plurality of risk criteria (Maxwell Column 6, lines 1-21)

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- Developing risk benchmark criteria for a combined plurality of risk criteria (Column 3, lines 10-15 'Evaluation ratios')
- Identifying a reward factor in relation to the reward benchmark value for each of the plurality of reward criteria (Maxwell Column 6, lines 1-21)
- Developing reward benchmarks values from a combined plurality of reward criteria (Column 3, lines 10-15)
- Automatically updating a master sheet with calculated risk and reward factors (Maxwell Figs 4 and 5)

Maxwell does not explicitly disclose the steps of:

- Collecting ideas from a plurality of sources;
- Identifying core equities of the organization
- Filtering said collected idea data by identifying potential business opportunities as those collected ideas that fall within the identified core equities
- Performing an opportunity analysis on said identified potential business opportunities to determine valid business opportunities

Karszes discloses evaluating collected business proposals by identifying core equities of the organization (Page 1, Step 2; 'determining whether a technology fits your business'), filtering said collected idea data by identifying potential business opportunities as those collected ideas that fall within the identified core equities (Pages 1-2, Steps 2-3; specifically step 3 'does your dairy have all the necessary practices, supplies, feeds, personnel and other resources in place and working properly to take

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advantage of the new practice or product?), and performing an opportunity analysis on said identified opportunity to determine its validity (Pages 2-3; Steps 4-5 'Financial Feasibility' and 'Risk Evaluation'). It would have been obvious to a person of ordinary skill at the time of invention to include the steps of Karszes to the disclosure of Maxwell in order to systematically determine if a company should incorporate a new product, process or technology to the existing structure of the business.

The references do not explicitly disclose the particular risk and reward criteria as well as performing a final assessment based on said master sheet for an action selected from the group consisting of go, no go, and maybe. However Maxwell notes that the "nature of the products in the product database will define the context and content of the questions to which the decision maker responds" (i.e. risk and reward criteria; Column 4, lines 37-39; Also note the variety and depth of question in FIG 4)). It would have been obvious to a person of ordinary skill to allow for the user specific entry of risk and reward criteria in the disclosure of Maxwell so that the specific goals and objectives of the business are maintained. Each business has different criteria, and allowing the business to design its own evaluation criteria and questions that best suits its goals ensures that the most optimal decision is made.

With regards to the step of performing a final assessment based on said master sheet for an action selected from the group consisting of go, no go, and maybe, Official Notice is taken that it is notoriously old and well known to utilize a risk-reward analysis to make decisions on the future prospects of a particular endeavor. It would have been obvious to a person of ordinary skill in the art to include this step to the disclosure of

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Maxwell in view of Karszes so that the future resources of the entity can be directed toward advancing the opportunity, pursuing a different route, or tweaking the current idea.

Re Claim 12: Maxwell in view of Karszes discloses the process according to claim 11 but does not explicitly disclose wherein the final assessment action of "GO" is followed by the steps of:

- Identifying a potential customer
- Establishing a rapport with the identified potential customer
- Logging customer information into the database
- Isolating problems and priorities in connection with the identified customer;
and
- Installing a capture team and a lead for the capture team for the identified customer

Official Notice is taken that these steps are notoriously old and well known in everyday business practice as a means of establishing relationships with customers that a business hopes to acquire. It would have been obvious to a person of ordinary skill in the art at the time of invention to include these steps to the disclosure of Maxwell in view of Karszes so that once an opportunity is found to be a worthwhile venture, the business can begin to implement the opportunity as opposed to simply analyzing the feasibility.

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Re Claim 13: Maxwell discloses the process according to claim 1 but does not explicitly disclose the steps wherein said step of committing resources includes the steps of:

- Conducting meetings to determine availability of resources
- Rendering a decision on one of an action to commit resources, not to commit resources, and maybe commit resources
- Adding relevant information to said business development database, providing feedback to a capture team and archiving unused data if a decision not to commit resources is made.
- Returning opportunity to the capture team if a decision to maybe commit resources is made;
- Completing a task sheet requesting support;
- Forwarding the completed task sheet to a selected company division and;
- Completing a capture plan in said business development database

Karszes discloses five points that help to evaluate a new technology including determining the availability of resources, a decision to commit the resources, determination of the financial feasibility of the project, performing research on the project and performing a risk evaluation. It would have been obvious to a person of ordinary skill in the art at the time of invention to include these steps to the disclosure of Maxwell so that every decision takes into account a variety of factors that could effect the business down the line.

Furthermore Official Notice is taken that the formation and completion of a task list related to a particular project is notoriously old and well known in the art and would have been obvious to a person of ordinary skill as a means to organize potentially complex operations. In any project involving a number of tasks, there are some tasks that take priority over others, or need to be completed before the start of a separate task (i.e. critical path). A task list helps to maintain a level of continuity and scheduling that prevents bottlenecks that waste time and resources.

Re Claim 14: Maxwell in view of Karszes discloses the process according to claim 13, but does not explicitly disclose wherein said task sheet includes identifying information about a contact, actions logged into said business development database, request being made, additional information and guidance, resources required, and requested due date. However as was discussed in claim 13, a task list related to a particular project is notoriously old and well known in the art and would have been obvious to a person of ordinary skill as a means to organize potentially complex operations. In any project involving a number of tasks, there are some tasks that take priority over others, or need to be completed before the start of a separate task (i.e. critical path). A task list helps to maintain a level of continuity and scheduling that prevents bottlenecks that waste time and resources.

Re Claim 15: Maxwell in view of Karszes discloses the process according to claim 14 but does not explicitly disclose wherein said step of completing a capture plan includes entering information into capture plan worksheets, said capture plan worksheets containing information related to: the buyer's need; the buyers; the internal

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capture team; information required about the need; information required about the buyer; information required about the money available; information required on the competition; the abilities of the competition; internal investment required; internal return on investment; the response to the need; the best sales argument; key and ghosting discriminators; return on investment analysis; the team; salespersons for each buyer; pre-selling contact plan; potential questions, objections and responses; several appropriate closing proposal approaches; and elements of the sales presentation.

Official Notice is taken that collecting the information stated above for the purposes of evaluating a potential business process and potential business relationship is notoriously old and well known in the art. All the information presented assists a company in evaluating a potential alliance, and placing the business in a position to consummate said alliance. It would have been obvious to a person of ordinary skill in the art at the time of invention to include these steps to the disclosure of Maxwell in view of Karszes to that a business seeking a potential partner (buyer) has fully evaluated the potential of the alliance and furthermore placed themselves in a favorable position to achieve said alliance.

Re Claim 16: Maxwell in view of Karzes discloses the process according to claim 1 but does not explicitly disclose wherein said step of developing a proposal includes further steps of:

- Assigning a proposal number in said business development database
- Completing a modular process; and

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- Performing a final review of the modular process to produce a final proposal

Official Notice is taken that the steps of developing and reviewing a proposal for a business development process are old and well known in the art. It is standard business practice to present a proposal to counterparty in order to create a business relationship. It would have been obvious to a person of ordinary skill in the art at the time of invention to include these steps to the disclosure of Maxwell so that the proposal submitted is well organized and covers all necessary topics, so that the proposing entity places itself in a more favorable position to the counterparty. Since said counterparty will make the ultimate decision to accept the proposing entity as a partner, the submitted proposal should be completed as thoroughly as possible.

Re Claim 17: Maxwell in view of Karszes discloses the claimed method supra but does not explicitly disclose wherein said modular proposal process includes all the intimate steps disclosed in claim 17. However as was discussed in the rejection of claim 16, it is standard business practice to present a proposal to counterparty in order to create a business relationship. It would have been obvious to a person of ordinary skill in the art at the time of invention to include these steps to the disclosure of Maxwell so that the proposal submitted is well organized and covers all necessary topics, so that the proposing entity places itself in a more favorable position to the counterparty. Since said counterparty will make the ultimate decision to accept the proposing entity as a partner, the submitted proposal should be completed as thoroughly as possible.

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Re Claim 18: Maxwell in view of Karszes discloses the claimed supra but does not explicitly disclose wherein said step of determining if submission of said developed business proposal is a success results in any one of a yes, no, and maybe decision; performing the following steps when the success determination decision is a no decision:

- Post reviewing the business proposal
- Providing feedback to said step of developing a business proposal; and
- Archiving the proposal by amending the business development database with information relevant to the decision;
- Returning the proposal to said step of developing a business proposal when the success determination decision is a maybe decision; and
- Executing said business opportunity when the success determination is a yes decision.

However Official Notice is taken that these steps were old and well known in the art at the time of invention. First it should be noted that a yes no or maybe response are the only possible decisions that could be made and that as a result any response would be deemed a "success." Furthermore, if a no decision is rendered, it would have been obvious to a person of ordinary skill to review the rejected proposal in order to learn from any mistakes, and correct for these mistakes to strengthen future proposals. When a maybe decision is rendered, it would have been obvious to a person of ordinary

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skill in the art to return the proposal for tweaking and adjustments in order to boost the chances that the proposal will eventually be accepted, which is the inherent goal of any proposal. Finally, executing the proposal if a yes verdict is rendered would have been obvious to a person of ordinary skill, as this is the inherent goal of submitting the proposal. If the plan is not executed, the submission of the proposal is moot and represents a waste of time and resources for the business.

Response to Arguments

Applicant's arguments filed 10/30/2006 have been fully considered but they are not persuasive.

Applicant has presented arguments with regards to the examiner's rejection under 112 first paragraph and under 101 for lacking concreteness. With regards to the 101 rejection, the applicant has stated that the business opportunity for performance is forced to be more concrete by the development process and if one of ordinary skill in the art executes the steps disclosed in the specification on a plurality of business opportunities they would most likely identify the same business opportunities as being valid. The examiner does not agree with this statement. Essentially the 'result' of the present invention is subjectively based on the opinions of a number of individuals (Specification 'originator' Page 12 line 21). The opinions of a number of these originators are analyzed and weighted and a prediction is made as to the best business opportunity. The applicant is correct that the result is directed toward an estimate, prediction or approximation. However, the result still must be repeatable in order to be

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concrete. The examiner submits that the subjective analysis of one panel of individuals could come up with a different 'prediction' of the best business opportunity, than a second panel of individuals.

The examiner likens this to a panel of judges in a court. Using the Supreme Court panel of nine judges as an example, say five judges agree that one decision is correct, while the other four are of a dissenting opinion and believe the other decision is correct. Each judge's individual decision is based on a subjective analysis of what they deem as the right decision, but the final decision is a weighted score based on the majority opinion. Now, lets say that one judge in the majority, is replaced by a judge that concurs with the minority. If another analysis is done, the result will now be different, even though the information being analyzed does not change. There is not an intrinsically correct decision, but simply one based on subjective opinions. The result is therefore not intrinsically repeatable, but entirely dependent on the individuals that make up the panel. This is the same as the present invention. There is not an intrinsically correct decision (there would be no need for an analysis), and therefore the ultimate direction the business takes is dependent on subjective results. As analogized to the judging panel, replacing one opinion with another, even in view of the same decision with the same information, could produce a different (non-repeatable) result. Therefore the invention fails the test for concreteness.

With regards to the 112 first paragraph rejection, an appropriate rejection under 35 U.S.C. 101 should be accompanied by a lack of enablement rejection under 35 U.S.C. 112, paragraph 1, where the invention cannot operate as intended without undue

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experimentation. As a result of the inventions lack of a concrete result, a skilled artisan could not use the invention without undue experimentation, specifically with regards to the make-up of the decision panel.

With regards to applicants arguments concerning the rejections based upon the prior art, the applicant claims that a software application, having known quantities and costs is not suitable for the claimed invention. The examiner does not agree with the applicant that there is an extensive difference between the scope of a software decision and the present invention of a 'business opportunity.' Entire companies are built around software applications that are the 'core equity' of the business. To dismiss the decision to purchase software as 'simple' is misguided. While it is true that for some business a software purchase may have little to no impact, this is certainly not the case for all companies. The examiner has provided a reference that supports this teaching as evidence of the complexity of software applications, their importance and the decision process involved.

Furthermore, the Maxwell reference, while using the software application as an example, explicitly states that 'the present method and software application may be used to evaluate products, applications, services and people. The example provided herein is intended to be illustrative in that the questions to which a decision maker replies are directed towards attributes and functional features provided by the different accounting packages. However, the questions could be readily adapted to the attributes required of an employee, the features required of an employee, the features required in a product, or any other criteria or basis upon which a decision is to be made

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(Column 3, line 62 – Column 4, line 4).’ The examiner therefore submits that the applicant’s suggestion that Maxwell is a ‘system for evaluating the suitability of software applications to a situation,’ is limiting the scope of the reference further than intended. As per the applicant’s argument with regards to the amended filter criteria of claims 1 and 3, the Karzsies reference, previously cited with respect to other claims has been included. In addition the applicant asks the examiner to identify prior art providing the steps of grading strengths and weaknesses, entering project identifying information and forwarding identified potential business opportunities. The examiner has already done so in the previous Office Action (page 7) and thus maintains this citation.

Regarding claims 5-9, the examiner has pointed to additional features in Maxwell and Karszes in support. It should also be noted that many of the further refined criteria involve subjective criteria that further calls into question the concreteness of these steps with respect to U.S.C. 101. For instance in claim 8, how does one of ordinary skill in the art measure ‘integrity, intellectual honesty, and stress tolerance’ of a team of individuals? In claim 9, what constitutes ‘trying to do too much? What is an ‘experienced team’? What is the ‘right location?’

Concerning claims 16-17, a closer examination of Maxwell reveals that the reference does in fact disclose a modular proposal process (Column 2, lines 6-13, 39-41, 59-65)). Therefore the examiner is in fact fully supported in his assertions.

Concerning claims 10-15 and applicant’s submitted definition for benchmark criteria, the examiner contends that by the submitted definition of a benchmark as a defined value, the Maxwell reference discloses such values (Column 3, lines 10-19).

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Thus it appears, even by the definition cited by the applicant, the references meet the claim.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- PR Newswire. "Xpedian to Benefi from the X Internet." New York: Jul 31, 2001, pg 1 (5 pages).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

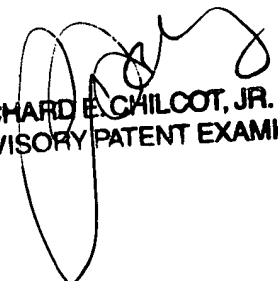
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Harbeck whose telephone number is 571-272-8123. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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SUPERVISORY PATENT EXAMINER